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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY OR
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U.S. PATENT OFFICE
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EXAMINER

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ART UNIT	PAPER NUMBER
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DATE MAILED: MAY 11 1950

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/016,641

Applicant(s)

Gately

Examiner

Jean F. Vollano

Group Art Unit

1621



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-15 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3(in part) and 4, drawn to a silyl compound, classified in class 556, subclass 426.
 - II. Claims 1-3(in part), 5-6 and 14-15, drawn substituted amines , classified in class 556 and 564, subclasses various .
 - III. Claim 7 (in part) , drawn to method of use of silylated compounds, classified in class 556, subclass 426.
 - IV. Claims 7 (in part) and 8, drawn to a method of use of substituted amines, classified in class 564, 556, subclass various .
 - V. Claims 9-13, drawn to a generic method , classified in class 568 and others, subclass various.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions they have different effects. Group I has compounds are silyl dialkyl or diaryl di oxygen compounds. Group II has secondary amine compound which happen to be substituted with and

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silyl group. Group II are basic compounds which can undergo chemistry which substitutes the hydrogen on the amine such forming a tertiary amine. The group I compounds are not basic and cannot undergo acid base reactions as such. The bonding of the silyl group to the nitrogen of the amine is very different from an carbon bond since the electronegativities of the groups (ie Si and N) are different from the bond electronegativities of the carbon-silicon bond. The empty 3d orbital of silicon is able to overlap with the filled 2px orbital of N to form a N-Si pi bond which is not the case for carbon and silicon. The chemical and physical characteristics of Group I are different from group II and thus they have different effects. Finding a silyl amine compound would not necessitate a rejection of the compounds in Group I.

3. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product claimed can be used in a materially different process. The organo silicon compounds of a can be used to form organo silicon polymers.

4. Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product claimed can be used in a materially different process

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the Si-N groups can be cleaved and reacted to form compounds such as hexamethylcyclotrisilane found in US4788309

5. Inventions III, IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects invention III is a method of preparing organosilyl aromatic compounds wherein invention IV forms nitrogen silyl compounds with different chemical and physical properties. Method in invention V is a generic method which does not necessarily encompass either groups III or IV and thus has a different scope and a different effect.
6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
8. A telephone call was made to Mr Edward Irons on 1/4/98 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr J F Vollano whose telephone number is (703) 305-4483. The examiner can normally be reached on Monday to Thursday from 6:30 to 5:00 .
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist , can be reached on (703)308-1701 . The official fax phone number for the organization where this application or proceeding is assigned is (703)308-4556. It should be noted that the examiner cannot immediately work on a fax sent to this number.
11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.



GARY GEIST
SUPERVISORY PATENT EXAMINER
TECH CENTER 1000

JFV

January 5, 1999